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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,368	09/30/2003	Randal T. Byrum	END-5092.515157	3221

26874 7590 05/11/2005
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EXAMINER

MENDOZA, MICHAEL G

ART UNIT PAPER NUMBER

3731

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,368

Applicant(s)

BYRUM ET AL.

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-15 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 22 February 2005 have been fully considered but they are not persuasive. The Applicant has amended the preamble of Claim 1 to include the phrase "gastric band". A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).
2. The recitation "gastric band" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
3. Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection. The Applicant amended Claim 13 to include the limitation of encircling a portion of the stomach. The new claim limitation changes the scope of the claim requiring new consideration.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/677,088. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications teach a strap; first and second end portions and an attachment mechanism.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-3 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahn et al. 5707378.

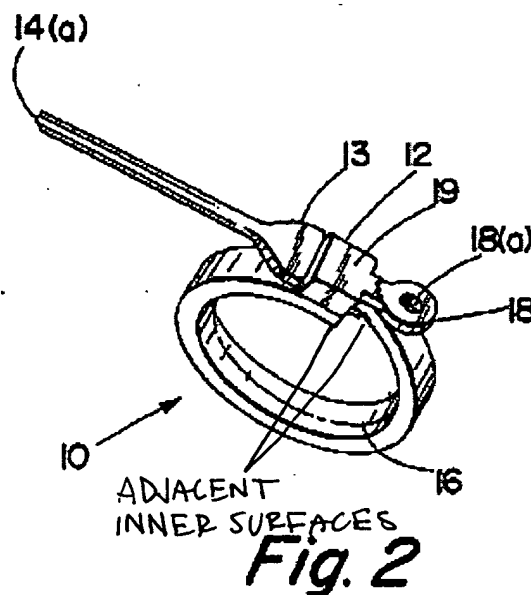
8. Ahn et al. teaches an implantable band for treatment of a medical condition, the band, comprising: a strap having an inner and outer surface; first and second end portions disposed at either end of the strap, the first and second end portions configured to be attached to each other; at least one of the first and second end portions comprising a non mechanical attachment mechanism; wherein the first end portion carries either hook or loop material and the second end portion carries the other of hook or loop material; wherein the inner surface of the first end portion carries either hook or loop material and the outer surface of the second end portion carries the other of hook or loop material; wherein the non-mechanical attachment mechanism comprises adhesive; wherein one of the inner and outer surfaces of the first end portion carries a first adhesive and one of the inner and outer surfaces of the second end portion carries a second adhesive, whereby the first and second adhesives adhere to each other upon mutual contact; wherein the non-mechanical attachment mechanism comprises the first and second end portions being configured to be attached to each other by energy bonding (col. 5, lines 35-44).

9. Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Vincent 5601604.

10. Vincent teaches a method of implanting a gastric band for treatment of a medical condition, comprising the steps of: providing a strap configured to encircle a portion of the stomach, the strap having: an inner and outer surface; first and second end

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portions disposed at either end of the strap, the first and second end portions including respective inner and outer surfaces which correspond to the inner and outer surfaces of the strap; encircling a portion of the stomach with the strap; location the first end portion adjacent the second end portion so that an interface is formed therebetween (col. 2, lines 50-58); applying energy to the interface until the first and second end portions are securely attached together (mechanical/physical energy is required to push portion 13 through portion 19 to secure the ends together); wherein the respective inner surface of the first and second end portion are disposed adjacent each other.



Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn et al.

13. As to claim 4, Ahn teaches the claimed invention except for the inner surface of the second end portion carries the other of hook or loop material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the inner surface of the second end portion carry the other of hook or loop material, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

14. As to claims 5-8, Ahn teaches the band of claim 1. It should be noted that Ahn fails to specifically teach wherein the non-mechanical attachment mechanism comprises magnetic material. However, Ahn does disclose; in col. 5, lines 35-44, that the strap may be locked in place by any suitable means known in the art (fasteners, snaps, belt buckles, friction type buckling system, or other systems known in the art). Magnetic fasteners are well known in the art as evidenced by U.S. Patents 5274889, 5249338, 4779314, 4458395, and 2637887. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use magnetic material as an alternative means of fastening.

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Ahn et al.

16. Vincent teaches the method of claim 13. It should be noted that Vincent fails to teach wherein the energy applied in the step of applying energy is chosen from the

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group consisting of vibratory energy, RF energy, ultrasonic energy, harmonic energy and thermal energy.

17. Anh et al. teaches a method of attaching to ends of a strap together using a common mechanical energy. Ahh also teaches that is known to use other forms of attachment that do not use mechanical/physical (such as melting). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach to ends of a strap together using thermal energy as alternative to physical/mechanical attachment because it is old and well known in the art of fastening to do so (col. 5, lines 35-44).

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-44963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MM



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